

**REMARKS****Interview request**

Applicants respectfully request a telephonic interview after the Examiner has reviewed the instant response and amendment. Applicants request the Examiner call Applicants' representative at (858) 720-7961. In compliance with Rule 133 (37 C.F.R. §1.133), a PTO 413A Applicant Initiated Interview Request Form is attached herein.

In the Notice of Non-Compliance, mailed May 29, 2008, the Office states on the Continuation Sheet that "[t]he amendment to replace paragraph [2] on page 1 of the specification filed 2/8/08 is confusing. It [is] marked as deleting "6J" and inserting "6AJ." However, a review of the last entered amendment to the same paragraph filed 11/21/05 reveals that there is no "6J" but "6AJ."

By way of this Response, Applicants hope to clarify for the Office the confusion surrounding the amendments made to the specification, including the amendments made to paragraph [2] of the specification.

**Summary of Prosecution**

With each Response that Applicants have filed with the Patent Office during prosecution of this application, Applicants have respectfully tried to explain the amendments made to the specification. However, for further clarity, Applicants will provide below a summary of the prosecution of this application in regards to the amendments made to the specification. Portions of text taken directly from responses previously filed with the Office will be *italicized* and in quotations.

**Response to Notice to File Missing Parts of Nonprovisional Application – mailed by Applicants on February 20, 2002**

On page 2 of this Response, Applicants requested the following:

**“In the Specification**

*Please replace the paragraph beginning at page 1, line 10, with the following rewritten paragraph:*

*--This disclosure includes a computer program listing appendix, containing appendix A, B, and D. Appendix C is submitted herewith as a paper copy, as Figures 6A - 6AJ. The appendices A, B, C and D are incorporated herein by reference--*

*Please insert the following paragraph, beginning at page 9, line 23:*

*--Figures 6A-6AJ identify the string of PKS modules responsible for production of the compounds. The identity of said modules is shown under the compound names.--”*

On page 5 of this response, Applicants included the “Version with Markings to Show Changes Made”.

**“In the Specification:**

*On page 1, line 10, please delete “This disclosure includes a CD appendix.” and insert --This disclosure includes a computer program listing appendix, containing appendix A, B, and D. Appendix C is submitted herewith as a paper copy, as Figures 6A - 6AJ. The appendices A, B, C and D are incorporated herein by reference.--*

*On page 9, line 23, after “library” insert --Figures 6A-6AJ show hieroglyphs under the compound names, which identify the string of PKS modules responsible for production of the compound. --”*

Unfortunately, there were no markings to show changes made on the “Version to Show Changes Made”, and the text of the amendments made to page 9 of the specification are not the same on page 2 and page 5 of the Response. Applicants inadvertently made these errors.

**Response to Restriction Requirement – mailed by Applicants on November 25, 2002**

In this response amendments were made to the specification but not to the portions that are at issue.

**Office Action dated July 29, 2005**

On page 2 of the Office Action, item 2, the Office explains how the “amendment to the specification filed 3/5/02 is not in compliance with 37 C.F.R. 1.121 because no marked-up version of the amendment is provided.” Applicants would like to point out that the date of the amendment was not March 5, 2002 but February 20, 2002.

**Response to Office Action – mailed by Applicants on November 18, 2005**

On page 2 and 3 of the Response, Applicants provided the marked-up version that was lacking from the Response to Notice to File Missing Parts and presented new amendments to the specification. The text of pages 2 and 3 of the Response is provided below.

*“The following represents marked-up versions of the amendments to the specification included in applicants’ Response to Notice to File Missing Parts of Nonprovisional Application filed February 20, 2002:*

**Paragraph [2] on page 1:**

*This disclosure includes ~~a CD-appendix~~ a computer program listing appendix, containing appendix A, B, and D. Appendix C is submitted herewith as a paper copy, as Figures 6A - 6AJ. The appendices A, B, C and D are incorporated herein by reference.*

**Paragraph [36] on page 9:**

*Figure 5 shows a flowchart of a matching method for the generation of the CHUCKLES strings used for all polyketides in a library. Figures 6A-6AJ show hieroglyphs under the compound names, which identify the string of PKS modules responsible for production of the compound.*

*Please accept the following **new** amendments to the specification: (emphasis added)*

**Please replace paragraph [1] on page 1 with the following rewritten paragraph:**

*This ~~applications~~ application asserts priority to U.S. Provisional Application Nos.: 60/237,382 filed October 4, 2000 by inventor Daniel Santi entitled DEVELOPMENT AND SCREENING OF A VIRTUAL POLYKETIDE LIBRARY; and 60/207,331 filed May 30, 2000 by inventors Daniel Santi, Michael Siani and Chaitan Khosla entitled DESIGN OF POLYKETIDE SYNTHASE GENES, all of which are incorporated herein by reference.*

**Please replace paragraph [2] on page 1 with the following rewritten paragraph:**

*This disclosure includes a computer program listing appendix, containing appendix A, B, and D. Appendix C is submitted herewith as a paper copy, as Figures 6A - ~~[[6AJ]]~~ 6J. The appendices A, B, C and D are incorporated herein by reference.”*

The new amendments made directly above to paragraph [2] on page 1 of the specification were made in error. Additionally, since the amendments made to paragraph [36] on page 9 of the specification, as stated on pages 2 and 5 of the Response to Notice to File Missing Parts, did not match, the amendment that was intended was herein clarified.

**Preliminary Amendment and Request for Continued Examination (RCE) – mailed by Applicants on November 7, 2006**

On page 3 of the Preliminary Amendment the following amendments to the specification were requested:

*“Please replace paragraph [2] on page 1 with the following paragraph:*

*This disclosure includes a computer program listing appendix, containing appendix A, B, and D. Appendix C is submitted herewith as a paper copy, as Figures 6A - 6AJ. The appendices A, B, C and D are incorporated herein by reference.*

*Please add the following new paragraph after paragraph [2] of the specification:*

*Appendix A, B, and D are contained on compact disc. The content of the following submission on compact disc is incorporated herein by reference in its entirety: A computer readable form (CRF) of Appendix A-20055.00, (file name: 020220\_\_1044, date recorded: January 28, 2002, size: 32,768 bytes); Appendix B-20055.00 (file name: 020220\_\_1044, date recorded: January 28, 2002, size: 38,912 bytes); and Appendix D-Morph-library (file name: 020220\_\_1044, date recorded: January 28, 2002, size: 16,384 bytes).*

*Please replace paragraph [36] on page 9 with the following two paragraphs:*

*Figure 5 shows a flowchart of a matching method for the generation of the CHUCKLES strings used for all polyketides in a library.*

*Figures 6A-6AJ show hieroglyphs under the compound names, which identify the string of PKS modules responsible for production of the compound.”*

The amendment to paragraph [2] was made to fix the previous “new” amendment (*see* Response to Office Action – mailed by Applicants on November 18, 2005) wherein “Figures 6A - ~~[[6AJ]]~~ 6J” should have been kept as “6AJ”.

A new paragraph was added after paragraph [2] in response to a request made by the Office.

Paragraph [36] on page 9 was amended so that two paragraphs instead of one are shown. The text was not changed; the text of the previous amendment (*see* Response to Office Action – mailed by Applicants on November 18, 2005) was just broken up into two different paragraphs discussing two different sets of figures.

**Office Action dated November 30, 2006**

On page 2 of the Office Action, the Office notes that “the amendment to the specification filed 11/7/06 has not been entered because the amendment does not comply with 37 CFR 1.121. The amendments to replace paragraphs on pages 1 and 9 of the specification do not provide markings to show changes made.”

In addition, the Office states on page 3 of the Office Action that the amendments made to the specification in regards to Appendix A, B, and D being contained on a compact disc were not entered. The Office also states on page 3 that “it is noted that in the amendment to the specification filed 11/7/06, a new paragraph is to be inserted after paragraph 2 on page 1 of the specification. However, the paragraph numberings of all the subsequent paragraphs are not amended accordingly.” Applicants note that the renumbering of the entire specification under entry of a new paragraph is not required by Applicants; this would require the filing of a substitute specification every time an amendment was made to the specification.

Therefore, none of the amendments to the specification reproduced directly above were entered.

**Response to Office Action – submitted electronically on May 29, 2007**

On page 3 of the Office Action, Applicants again try to amend paragraph [2] of the specification so that “6J” is changed to “6AJ”:

***“Please amend paragraph [2] on page 1 of the specification as follows:***

*--This disclosure includes a computer program listing appendix, containing appendix A, B, and D. Appendix C is submitted herewith as a paper copy, as Figures 6A - [[6J]] 6AJ. The appendices A, B, C and D are incorporated herein by reference.--”*

In addition, on page 3, Applicants again try to add a new paragraph after paragraph [2].

***“Please add the following new paragraph after paragraph [2] of the specification:***

*--Appendix A, B, and D are contained on compact disc. The content of the following submission on compact disc is incorporated herein by reference in its entirety: A computer readable form (CRF) of Appendix A-20055.00, (file name: 020220\_\_1044, date recorded: January 28, 2002, size: 32,768 bytes); Appendix B-20055.00 (file name: 020220\_\_1044, date recorded: January 28, 2002, size: 38,912 bytes); and Appendix D-Morph-library (file name: 020220\_\_1044, date recorded: January 28, 2002, size: 16,384 bytes). --”*

**Response to Office Action – submitted electronically on February 8, 2008**

This Response was in reply to an Office communication stating that “the amendment filed 5/29/07 is not responsive to the previous Office action mailed 11/30/06” because the “amended claims are drawn to an invention that is related to but distinct from the originally elected invention Group IV.”

In this Response, Applicants submitted a complete response, identical to the response filed May 29, 2007 but including an argument traversing the Office's assertion that the amended claims were outside the scope of the elected subject matter.

Therefore, once again, Applicants requested on page 2 of the Response:

***“Please amend paragraph [2] on page 1 of the specification as follows:***

*--This disclosure includes a computer program listing appendix, containing appendix A, B, and D. Appendix C is submitted herewith as a paper copy, as Figures 6A - [[6J]] 6AJ. The appendices A, B, C and D are incorporated herein by reference.--*

***Please add the following new paragraph after paragraph [2] of the specification:***

*--Appendix A, B, and D are contained on compact disc. The content of the following submission on compact disc is incorporated herein by reference in its entirety: A computer readable form (CRF) of Appendix A-20055.00, (file name: 020220\_\_1044, date recorded: January 28, 2002, size: 32,768 bytes); Appendix B-20055.00 (file name: 020220\_\_1044, date recorded: January 28, 2002, size: 38,912 bytes); and Appendix D-Morph-library (file name: 020220\_\_1044, date recorded: January 28, 2002, size: 16,384 bytes). --”*

### **In Summary**

In the Notice of Non-Compliance, mailed May 29, 2008, the Office states on the Continuation Sheet that “[t]he amendment to replace paragraph [2] on page 1 of the specification filed 2/8/08 is confusing. It [is] marked as deleting “6J” and inserted “6AJ.” However, a review of the last entered amendment to the same paragraph filed 11/21/05 reveals that there is no “6J” but “6AJ.”



The Office also states that “Applicant is reminded that the amendment to the specification filed 11/7/06, which was not entered for reasons indicated in the Office action mailed 11/30/06 contains amendment to paragraphs [36] of page 9, etc., which is not in the amendment filed 2/8/08. If applicant still intends those amendment[s], it needs to be refiled as the amendment filed 11/7/06 was not entered.”

Thus, Applicants believe that they have explained the confusion surrounding the amendments to paragraph [2] on page 1 of the specification. In addition, they have requested the insertion of a new paragraph after paragraph [36] of the specification (*see* page 2 above of the current Response entitled “AMENDMENTS TO THE SPECIFICATION.” Thus, all of the amendments to the specification that were requested in the Preliminary Amendment and RCE – mailed by Applicants on November 7, 2006, have been requested again.

In view of the amendments and remarks made in this Response, the Examiner is respectfully requested to withdraw the outstanding objection to the specification and to pass this application to issue.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 300622005500. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

As noted above, Applicants have requested a telephone conference with the undersigned representative to expedite prosecution of this application. After the Examiner has reviewed the instant response and amendment, please telephone Applicants' representative at (858) 720-7961.

Dated: September 29, 2008

Respectfully submitted,

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